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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,352

10/07/2005

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Q90808

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23373 7590 01/13/2009  
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EXAMINER

TOLIN, MICHAEL A

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

01/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,352	<b>Applicant(s)</b> GASTALDI ET AL.	
	<b>Examiner</b> MICHAEL A. TOLIN	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The new language directed to applying a bi-adhesive sheet to the back of the ornaments is confusing in that it is unclear if a single bi-adhesive sheet is applied to multiple ornaments or if the limitation is satisfied by applying separate bi-adhesive sheets to each individual ornament. The examiner suggests adding language supported by the original disclosure to clarify the intended scope of this limitation. The examiner cannot offer a more specific suggestion because the specification does not appear to clarify this issue. For the purpose of examination, the claim is considered to be satisfied by either possibility, i.e. applying plural bi-adhesive sheets or applying a single bi-adhesive sheet to multiple ornaments.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (US 5972144) in view of Jeffers (US 2500494), Tukakoshi (US 5226993) and Schickedanz (US 3658971).

Hsu, Jeffers and Tukakoshi are applied as set forth in numbered paragraphs 3 and 5 of the previous office action, mailed 09 July 2008.

The amendment of 08 October 2008 adds new language directed to applying the bi-adhesive sheet to the back of ornaments prior to the removal of the ornaments from the mold. It is generally known in the art that the adhesive force of a bi-adhesive sheet may be used to facilitate removal of an article from a mold. See Schickedanz (column 2, lines 19-23 and lines 35-42; column 4, lines 30-46; Figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the bi-adhesive sheet suggested by Tukakoshi to the ornaments of Hsu as modified by Jeffers prior to removal from the mold because one of ordinary skill in the art would have been motivated to facilitate removal from the mold in accordance with known methods as evidenced by Schickedanz.

As noted above in the 35 USC 112 rejection, there is some confusion as to whether the new step requires application of a single bi-adhesive sheet to plural ornaments or whether the step is satisfied by application of bi-adhesive sheets to individual ornaments. In any event, Schickedanz suggests application of a bi-adhesive

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sheet to a plurality of molded articles to suitably remove the articles in an efficient manner (Figure 1; column 4, lines 3 for-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply a single bi-adhesive sheet to plural ornaments because one of ordinary skill in the art would have been motivated to suitably remove the molded ornaments in an efficient manner using known methods as evidenced by Schickedanz.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu in view of Jeffers, Tukakoshi and Schickedanz as applied to claim 5 above, and further in view of Mohiuddin (US 4350739).

Mohiuddin is applied as in numbered paragraph 4 of the previous office action.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kasprzak (US 5140752) in view of Hsu, Jeffers, Tukakoshi and Schickedanz.

Kasprzak is cited to show that is generally well known to adhere a decorative ornament to a substrate adhesively (Figure 1; column 1, lines 5-26). While the examiner acknowledges that Kasprzak is mainly directed to the careful removal of such ornaments from a substrate, it is clear from Kasprzak that such ornaments are well known, as is the adhesive attachment of such ornaments to a substrate. Hsu and Jeffers are applied as in numbered paragraphs 3 and 6 of the previous office action for suggesting a suitable method of manufacturing such an ornament. Tukakoshi is applied as in numbered paragraph 5 of the previous office action for providing a suitable known

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method of adhering such a decorative article to a substrate with a bi-adhesive sheet.

Schickedanz is applied as above in the rejection of claim 5 for suggesting the new limitation of applying a bi-adhesive sheet to the back of the ornaments prior to removal of the ornaments from the mold.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kasprzak in view of Hsu, Jeffers, Tukakoshi and Schickedanz as applied to claim 5 above, and further in view of Mhiuddin.

Mhiuddin is applied as in numbered paragraph 4 of the previous office action.

### ***Response to Arguments***

8. Applicant's arguments filed 08 October 2008 have been fully considered but they are not persuasive.

As to the argument that Applicant's invention is directed to a process in which cutting is performed after de-molding, it is noted that this argument is not commensurate in scope with the claims since they do not provide a cutting step.

Applicant's remaining arguments are moot in view of the new grounds of rejection which were necessitated by the new language added to claim 5.

### ***Conclusion***

9. As noted above, Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL A. TOLIN whose telephone number is (571)272-8633. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Tolin/  
Examiner, Art Unit 1791

/Richard Crispino/  
Supervisory Patent Examiner, Art Unit 1791